

### DETAILED ACTION

*The following is in response to the amendments and arguments dated 6/19/2009.*

*Claims 1-133 are pending, claims 51-133 have been withdrawn from consideration.*

### *Specification*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-50 recite a process comprising the steps of providing, utilizing, and consulting. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the

method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

A mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. In addition, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. **This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.** See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle (US 5233513) in view of Bird (Purchasing and Supply Management Sept 1993).

Specifically as to claim 1, Doyle discloses a customer related technical services for obtaining an optimal financial result of a production plant by continuously applying the steps of: a) providing a process description; b) utilizing connected software tools and hardware tools; and c) consulting an empirical database of experience (see abstract, figures 1A-3D with associated description, col 7-col 9) but does not specifically disclose that the empirical database specifically includes data from project experience, regional business information, data relating to technical equipment, and cost models.

Bird discloses consulting empirical databases of experience where the databases include whatever the client needs the reports to include, including data relating to technical equipment, cost models, etc. (see page 3).

It would have been obvious to one of ordinary skill in the art to include in the system of Doyle the ability to specialize the databases as taught by Bird since the claimed invention is merely a combination of old elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claim 2, the step of providing a process description is performed a plurality of times worldwide according to a same criterion for each said process description (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 3, utilizing homogenous forms of marketing/acquisition, standard basic contract forms, standard offer management, mobilization, operation and demobilization (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 4, performing the according to defaults of a manual(see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 5, repeating steps a), b) and c) multiple times for different locations; utilizing a same course of action for steps a), b) and c) for each location worldwide ; providing best practice sharing with respect to internationally comparable standards; and introducing continuous improvement processes on a basis that is always the same (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 6, describing internal and external processes in a manual, the internal processes run on a customer plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125-128).

Specifically as to claim 7, the manual is in writing in at least one of text form and diagram form plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125-128).

Specifically as to claim 8, wherein the manual is in a form readable by a personal computer and which can be printed plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125-128).

Specifically as to claim 9, wherein the manual is on a CD-ROM plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 10, wherein the manual is on the World Wide Web (see col 219 to col 222 and col 125 to col 128, col 213).

Specifically as to claim 11, wherein the manual is in an encoded form that can only be retrieved by a password (see col 219 to col 222 and col 125 to col 128, col 213).

Specifically as to claim 12, wherein the manual is embedded into a virtual scene and includes simulation possibilities (see col 219 to col 222 and col 125 to col 128, col 213).

Specifically as to claim 13, wherein the manual has a portal with selection possibilities for different technical services in its form that can executed on the PC (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 14, subjecting content of the manual to a dynamic process which derives from an integration of a dynamically growing experience database into the manual (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 15, wherein the manual takes product-specific bits of information and plant-specific bits of information from experience databases from worldwide plants having a

same production target and the same production methods (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 16, wherein technical developments as well as methodical developments are a part of the experience database (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 17, wherein the manual contains a work flow for maintenance teams (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 18, wherein the manual suggests method groups and methods as work instructions dependent on the work flow (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 19, wherein the manual organizes a consideration and the following implementation of the workers utilizing centers of excellence, said centers of excellence having special knowledge (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 20, wherein the maintenance work is carried out by local units supported by the centers of excellence (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 21, wherein the centers of excellence are distributed and networked such that it is always possible to access resources (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 22, wherein the resources are experts (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 23, wherein the experts can be reached 24 hours a day (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 24, wherein said software tools are available via the World Wide Web (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 25, providing a system for implementing services with individual components which are obtainable on the market, said individual components being connected to a web-based knowledge-based database that continuously works with experience values (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 26, wherein the individual components are software tools (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 27, utilizing external data and external tools for supplementing (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 28, transmitting data in an encoded fashion between the centers of excellence and the local units (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 29, improving standard software utilizing originally present experience data and improved experience data, said standard software being supplemented by

experiences present in the database, utilizing worldwide knowledge therefor (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 30, monitoring a condition of the plant utilizing remote expert centers (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 31, providing an application service host that is one of centrally arranged and arranged remotely connected by the Internet, distribution and data forwarding ensues worldwide (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 32, wherein the application service host is isolated from the individual customer programs and has fire walls between the customers, so that the customer data cannot be viewed externally (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 33, collecting data from all customers and OEM's in an anonymous fashion using a central database (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 34, providing non-confidential portions of said data collected from the customers available via the World Web (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 35, wherein the central database is on distributed servers (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).



Specifically as to claim 36, selecting databases by a portal (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 37, wherein the step of selecting is by menu prompting.

Specifically as to claim 38, wherein the experience database represents reference data from a provider's projects and customer projects, OEM data, industrial standard data, project experience data from other projects, standard maintenance, and standard operating plans (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 39, modifying OEM defaults and utilizing modified defaults when the OEM defaults are not advantageous for the customer (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 40, wherein said modified defaults are maintenance intervals (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 41, internationally acquiring experience data; organizing said experience data in a business-specific and system-specific manner; and using key performance data and key performance indicators (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 42, providing feedback loops for performing the services with a start at the original plant condition data (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 43, wherein plant start data serves to introduce initial measures (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 44, within a framework of measures how the plant reacts to the initial measures; and deriving further measures for improvement from the learning step (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 45, entering an effect of measures into the experience database, as well as key performance data (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 46, introducing a request for changing the procedure which is business-specific into the manual (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 47, introducing modified methods and tools into the manual due to the necessary changes in the procedure (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 48, improving services by a) a database, b) a manual, c) local project experiences, which are directly realized, and d) an improvement of the software tools and hardware tools (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 49, wherein said software tools are provided by access through the World Wide Web (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 50, providing that tools for improvement permanently communicate with the database (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

With regards to applicants' arguments that the 35 USC 101 rejection was in error because there is computer readable media in the claim, Examiner disagrees. As stated above, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. In addition, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/  
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